The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LIAM DAVID COMERFORD and DAVID CARL FRANK

Appeal No. 2005-1952
Application No. 09/460,913

ON BRIEF

Before KRASS, JERRY SMITH, and BLANKENSHIP, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 6-8 and 13-19.

We affirm.

BACKGROUND

The invention relates to spoken language interfaces in association with computing apparatus. Claim 6 is reproduced below.

> 6. A method of automatically providing a spoken language interface for a user with respect to at least one external network with which the user interacts, wherein the user possesses a portable spoken language interface device having a data structure for storing one or more user interface data sets used to provide one or more spoken language interfaces, the method comprising the steps of:
>
> the device requesting a spoken language interface data set from the external network upon discovery of the external network;
>
> the external network transferring the spoken language interface data set to the device; and
>
> loading the spoken language interface data set into the data structure of the device for use by the user interfacing with the external network.

The examiner relies on the following references:

Freadman	5,481,616	Jan. 2, 1996
Basore et al. (Basore)	5,752,232	May 12, 1998
Abella et al. (Abella)	6,044,347	Mar. 28, 2000 (filed Aug. 5, 1997)
Surace et al. (Surace)	6,144,938	Nov. 7, 2000 (filed May 1, 1998)
Mozer et al. (Mozer)	US 2002/0091513 A1	Jul. 11, 2002 (effective filing date Jun. 9, 1999)

Claims 6, 7, 13, and 19 stand rejected under 35 U.S.C. § 102 as being anticipated by Mozer.

Claims 14 and 15 stand rejected under 35 U.S.C. § 103 as being unpatentable over Basore, Mozer, and Surace.

Claims 8, 16, and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mozer and Freadman.

Claim 18 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mozer, Freadman, and Abella.

Rejections against claims 1-5 and 9-12 have been expressly withdrawn by the examiner in response to arguments in appellants' brief.

We refer to the Examiner's Answer (mailed Jul. 28, 2004) for a statement of the examiner's position and to the Brief (filed Apr. 30, 2004) and the Reply Brief (filed Oct. 1, 2004) for appellants' position with respect to the claims which stand rejected.

OPINION

Based on appellants' arguments in the Brief and the rules effective at the time of filing thereof, we select claims 6, 13, 14, 16, and 18 as representative of the claims on appeal. See 37 CFR § 1.192(c)(7) (2003).

Appellants disagree with the examiner's finding that Mozer anticipates claim 6. The claim requires that the device request a "spoken language interface data set" from the external network. According to appellants, the "spoken language interface data set" distinguishes over the recognition sets and weight sets used by pattern recognition

system (neural network) 108, as described by Mozer at page 3, ¶ 26 et seq. In particular, appellants contend that the instant specification section (spec. at 3, ll. 3-12) quoted at the top of page 13 of the Brief "explicitly defines" the requirements of a "spoken language interface data set."

We disagree that the section sets forth an explicit definition for the relevant recitation. In fact, the phrase does not even appear. The section relates that a spoken language interface is defined in sets of user interface files. The files are referred to by various names, depending on the role they play in structuring the interface. There is no indication that a spoken language interface is required to contain one or more of the listed files that are "referred to" by the specification.

Appellants seem to suggest, at page 2 of the Reply Brief, that the data sets described by Mozer fail to play a role in "structuring the interface." We also disagree with that implication. The spoken language interface would not function in Mozer absent the recognition sets and weight sets; the data set thus plays a role in structuring the interface.

More important, however, claim 6 does not contain any language about structuring an interface, much less language specific to whatever "structuring" that appellants believe to be missing from Mozer. Claims are to be given their broadest reasonable interpretation during prosecution, and the scope of a claim cannot be narrowed by reading disclosed limitations into the claim. See In re Morris, 127 F.3d

1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). The claims may be amended to reflect the scope intended by appellants, obviating the uncertainties in attempting to infer definitions from teachings in the specification. See In re Zletz, 893 F.2d at 321, 13 USPQ2d at 1322 ("[D]uring patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.").

Appellants add arguments in the Reply Brief (at 3-4) that Mozer lacks the teachings of the user interacting with an external network and that the spoken language data set is requested from the external network upon discovery of the external network. Appellants base the first allegation on an embodiment in Mazer that has not been applied against the claims, where the data sets may be retrieved from compact disks in a compact disk changer (at 3, ¶ 35 et seq.). Appellants base the second allegation on page 2, ¶ 23 of Mazer, concluding that in Mazer it is assumed that the external medium (from which the data sets are retrieved) is already connected to the base unit.

Mazer at page 3, ¶ 30 discloses that the external medium may be, for example, a remote server or a web site. Further, the reference at page 4, ¶ 42 describes in detail a user interacting with an external network and retrieval of data sets from the external network. Appellants' remarks in the briefs are not persuasive in showing that Mazer lacks what is required by instant claim 6 relating to the external network.

Appellants argue, with respect to instant claim 13, also rejected under § 102 over Mazer, that the reference fails to disclose modifying a predetermined parameter of the device. Appellants contend that the predetermined parameter of the device which may be modified is "defined by the specification as affecting an operating function of the device," but the basis for the position is pointing to an "illustration" in the specification without "loss of generality." (Reply Brief at 4.)

Appellants have not shown a limiting definition in the specification. Nor have appellants shown why the claims should be limited to the disclosed embodiments, notwithstanding the language to the contrary at page 43, lines 14 through 18 of the specification. We are thus not persuaded of error in the examiner's finding that Mazer discloses operatively modifying a predetermined parameter of the device at page 3, ¶ 33.

Even were we to find the argument persuasive, we note that claim 13 sets forth modifying "at least one" of two alternatives. The claim is thus met by a disclosure of both, or either, of the two alternatives, as appellants appear to recognize in remarks at page 14 of the Brief. The examiner relies on page 3, ¶ 29 for disclosure of the claimed modification of an application running on the device. Appellants add the allegation at the bottom of page 4 of the Reply Brief that Mozer fails to disclose prompting the user for information to modify at least one of the two alternatives. Appellants read Mozer page 3, ¶ 33 as taking action without prompting the user. Appellants do not address

the alternative at page 3, ¶ 20, which expressly describes "prompts" to the user in association with applications running on the device.

We have considered all of appellants arguments in response to the § 102 rejection. We sustain the rejection of claims 6, 7, 13, and 19 under 35 U.S.C. § 102 as being anticipated by Mozer.

Representative claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mozer and Freadman. Appellants argue that the references cannot be combined to show prima facie obviousness because Mozer and Freadman are nonanalogous art. Whether a reference in the prior art is "analogous" is a fact question. In re Clay, 966 F.2d 656, 658, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Appellants' argument thus contests the examiner's finding that Mozer and Freadman are analogous art.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. Id. at 658-59, 23 USPQ2d at 1060.

Appellants' field of endeavor, according to the first page of the specification, generally relates to spoken language interfaces employed in association with computing apparatus. Mozer relates to the same (e.g., p. 2, ¶ 12), as does Freadman

(col. 4, ll. 11-21). We therefore consider the examiner's finding to be supported by the references. Even were the references not in applicants' field of endeavor, both are reasonably pertinent to the particular problem with which applicants were involved; i.e. reasonably pertinent to improving spoken language interfaces employed in association with computing apparatus.

To the extent that appellants may argue there is no suggestion from the prior art to combine the references, we also find ample support for the examiner's relevant findings. The combination as applied against claim 16 contemplates providing the speech recognition capabilities as taught by Mozer in a PDA. Mozer provides an illustrative list of units in which the invention may be embodied (p. 2, ¶ 12), thus suggesting combinations with devices similar to those listed -- including the type of computer known as a PDA, as evidenced by Freadman (col. 1, ll. 1-10).

Appellants add an argument in the Reply Brief (at 7) that Mozer does not disclose a "portable" spoken language interface because the reference teaches the device is placed in a "base unit" of an electronic apparatus. According to appellants, the term "base unit" implies that the device is not intended for portable operation.

We disagree that a teaching of placing a spoken language interface device into a base unit (such as a computer) means that the device is not "portable" within the meaning of claim 16. Even were Mozer not to teach a "portable" device, Freadman teaches that a PDA may be operatively coupled with a portable device (e.g., Fig. 2).

We have considered all of appellants' arguments in defense of representative claim 16. We sustain the rejection of claims 8, 16, and 17 under 35 U.S.C. § 103 as being unpatentable over Mozer and Freadman.

For claim 18, the examiner adds the teachings of Abella regarding a dialog manager to the combination of Mozer and Freadman as applied against base claim 16. Appellants argue (Brief at 20) that Abella fails to teach or suggest a dialog manager having the "functionality as defined by the present specification." Appellants in the Reply Brief (at 7) tell us where this "definition" resides; i.e., specification page 7, lines 19 through 21, which merely relates what an embodiment of a dialog manager may comprise. Because appellants have not shown how the "dialog manager" of claim 18 distinguishes over Abella, and appellants have not shown why the invention should be limited to a particular disclosed embodiment (notwithstanding the instructions to the contrary in the final paragraph of appellants' written description), we sustain the § 103 rejection of claim 18.

Representative claim 14 has been rejected under 35 U.S.C. § 103 as being unpatentable over Basore, Mozer, and Surace. We note that claim 14 (and 15, the other claim in the group) depends from claim 6, rejected for anticipation over Mozer. The rejection (Answer at 6-7) does not apply Basore to the limitations of claim 14 and 15, but the listing of the reference appears to be an error related to an earlier rejection

of other claims that has been withdrawn. We thus consider Basore to be merely cumulative in its teachings.

Appellants seem to suggest (Brief at 16) that Mozer and Surace are nonanalogous art based on "dissimilar patent classifications." According to the front pages of the references, the references are classified in the same class (704) in the U.S. classification system. Classification carries some weight in determining whether a reference is analogous art; however, similarities and differences in structure and function of the inventions carry far greater weight. See In re Deminski, 796 F.2d 436, 442 n.3, 230 USPQ 313, 315 n.3 (Fed. Cir. 1986); In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973).

Mozer is in appellants' field of endeavor, as we have discussed supra. Surace relates, according to column 1, to computer-implemented voice user interfaces, which is within appellants' field of endeavor -- spoken language interfaces employed in association with computing apparatus. We find that both references are analogous art.

We have considered all of appellants' arguments but are not persuaded of error in the rejection of representative claim 14. We sustain the rejection of claims 14 and 15 under 35 U.S.C. § 103 as being unpatentable over Basore, Mozer, and Surace.

CONCLUSION

The rejection of claims 6, 7, 13, and 19 under 35 U.S.C. § 102 and the rejection of claims 8 and 14-18 under 35 U.S.C. § 103 are affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a). See 37 CFR § 1.136(a)(1)(iv).

AFFIRMED

ERROL A. KRASS
Administrative Patent Judge

JERRY SMITH
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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) AND
) INTERFERENCES

WAYNE L. ELLENBOGEN
RYAN, MASON & LEWIS, LLP.
90 FOREST AVENUE
LOCUST VALLEY, NY 11560